

**REMARKS/ARGUMENTS**

Claims 1-20 are pending in the application. Claims 1, 2, 8, 9 and 15 are independent claims. The Examiner has rejected claims 5, 7, 12, 14, 18 and 20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Under 35 U.S.C. § 102(e), the Examiner has rejected claim 1 as anticipated by U.S. Patent No. 6,208,988 issued to Schultz (hereinafter "Schultz"), and has rejected claims 2 and 3 as anticipated by U.S. Patent No. 6,385,619 issued to Eichstaedt *et al.* (hereinafter "Eichstaedt"). The Examiner has rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Eichstaedt in view of U.S. Patent No. 5,557,227 issued to Cook (hereinafter "Cook"). The Examiner has further rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Eichstaedt in view of U.S. Patent No. 5,557,227 issued to Heckerman (hereinafter "Heckerman"). The Examiner has also rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of U.S. Patent No. 6,473,755 issued to Evans (hereinafter "Evans"). Finally, the Examiner has rejected claims 9-20 "for the reasons given above [for the correspondingly rejected claims 1-8]."

**A. Rejections under 35 U.S.C. § 101**

The Examiner has rejected claims 5, 7, 12, 14, 18 and 20 under 35 U.S.C. § 101 as being directed to a mathematical function, instead of a process method step.<sup>1</sup> Although all of the rejected claims are dependent claims that simply narrow one aspect of a process method step, the claims have been amended to clarify the fact that they recite patentable method steps.

The Examiner has also rejected claims 5, 7, 12, 14, 18 and 20 under 35 U.S.C. § 101 for describing an inoperative invention. In the case of the parameter "*n*" in the exponential decay function of claims 5, 12, and 18, and further in the case of the parameter "*N*" in the power law

---

<sup>1</sup> Office Action at p. 2.

function of claims 7, 14, and 20, a person of ordinary skill in the relevant art would understand that those parameters cannot have values that make the invention inoperable. Nonetheless, claims 5, 7, 12, 14, 18 and 20 have been amended to specify the permissible range of the parameters, thus further clarifying the patentability of those claims.

Since the claims recite patentable process method steps both originally and as amended, and further since the claims as interpreted by a person of ordinary skill in the art both originally and as amended meet every test of operability, Applicant respectfully requests reversal of the rejection of claims 5, 7, 12, 14, 18 and 20, and asks that the claims be allowed.

#### **B. Rejections under 35 U.S.C. § 102(e)**

The Examiner has rejected claim 1 under 35 U.S.C. § 102(e), as anticipated by Schultz. Specifically, the Examiner has argued that Schultz anticipates claim 1 by teaching all of the elements of claim one as shown:

Element of Claim 1	Citation to Schultz	Relevant Text of Schultz Citation
A <i>method</i> of selecting <i>documents</i> from a <u><i>data stream</i></u>	Abstract; Col. 1, ll. 5-20	A <i>method</i> of identifying at least one query theme <sup>2</sup> . . . identifying <i>documents</i> corresponding to a search topic or query, and . . . identifying and retrieving text and multi-media files . . . from a <u><i>database library</i></u> <sup>3</sup>
Selecting a <i>resource</i> having information comparable to said <u><i>data stream</i></u>	Col. 1, ll. 45-55	Each of the <i>document records</i> has . . . <i>metadata fields</i> . . . representing a degree of correlation between the <u><i>stored document</i></u> . . . and a document theme <sup>4</sup>
Selecting at least one <i>topic</i>	Fig. 2, #206, #208	SYSTEM IDENTIFIES . . . MAJOR <i>THEME</i> LIST; USER SELECTS A MAJOR <i>THEME</i> <sup>5</sup>

<sup>2</sup> Schultz, Abstract l. 1 (italics added).

<sup>3</sup> Schultz, col. 1, ll. 10-16 (emphasis added).

<sup>4</sup> Schultz, col. 1, ll. 51-55 (emphasis added).

<sup>5</sup> Schultz, Fig. 2 (italics added).

Element of Claim 1	Citation to Schultz	Relevant Text of Schultz Citation
Analyzing said <i>topic</i> against said <i>resource</i>	Col. 1, ll. 50-55	Each of the <i>document records</i> has . . . <i>metadata fields</i> . . . representing a degree of correlation between the stored document . . . and a document <i>theme</i> <sup>6</sup>
Analyzing said <i>topic</i> against said <i>data stream</i>	Col. 1, ll. 55-67	A results list is . . . document records . . . associated with the search query. A composite <i>theme</i> score is determined for each document theme . . . in the <i>document records</i> in the results list. <sup>7</sup>
Comparing results from said <i>data stream</i> analysis to results from said <i>resource</i> analysis to select a document from said <i>data stream</i>	Fig. 2, #208, #210	SYSTEM IDENTIFIES . . . MAJOR <i>THEME</i> LIST; USER SELECTS A MAJOR <i>THEME</i> ; USER CHOOSES ONE OF THE DISPLAYED DOCUMENT RECORDS, AND SYSTEM RETRIEVES THE CHOSEN DOCUMENT FROM THE DOCUMENT <i>DATABASE</i> <sup>8</sup>

The Examiner bears the initial burden of establishing a *prima facie* case of unpatentability. To establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the Examiner must demonstrate that a single prior art reference discloses all of the claim's essential elements.<sup>9</sup> *E.g.*, Thus, the "exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference."<sup>10</sup>

In the present case, this burden requires the Examiner to establish a *prima facie* case concerning the existence in Schultz reference of every claim element in the claimed invention. As the table above shows, the Schultz reference as cited by the Examiner fails to disclose all of

<sup>6</sup> Schultz, col. 1, ll. 51-55 (italics added).

<sup>7</sup> Schultz, col. 1, ll. 57-62 (emphasis added).

<sup>8</sup> Schultz, Fig. 2 (emphasis added).

<sup>9</sup> *Rockwell Inter. Corp. v. U.S.*, 147 F.3d 1358, 1363, 47 U.S.P.Q.2d 1027, 1031 (Fed. Cir. 1998); *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 U.S.P.Q.2d 1030, 1032 (Fed. Cir. 1997); *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985); *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

<sup>10</sup> *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

the claim elements related to the presence and analysis of a data stream as claimed in the present invention. Accepting *arguendo* the Examiner's citations to the Schultz reference as relevant, the claim element of "data stream" is variously analogized in Schultz by a database library, and by a document record. However, Schultz defines "document record" in the following manner:

Each document record archive has a plurality of document records each of which is associated with a stored document. Each of the document records has a plurality of metadata fields each of which stores *a numerical score* representing a degree of correlation between the stored document associated with the document record and a document theme, wherein the document theme corresponds to a subject, person or place associated with the stored document.<sup>11</sup>

In other words, the "document record" of Schultz is merely a numerical representation of a document's relevance to a theme. The "document record" of Schultz is clearly not a data stream as that element is claimed in the present invention. This limitation of the document record of Schultz makes it plain that Schultz furthermore does not anticipate the element of the present invention wherein both a resource analysis and a data stream analysis are performed and the results compared. For these reasons, the Examiner has failed to establish a *prima facie* case of anticipation. As in this case, where the Examiner fails to establish a *prima facie* case of anticipation, the rejection is improper and shall be reversed.<sup>12</sup> Accordingly, Applicant requests reversal of the rejection of claim 1.

The Examiner has rejected claims 2 and 3 under 35 U.S.C. § 102(e) as anticipated by Eichstaedt. Claims 2 and 3 of the present invention recite a method of selecting documents from a data stream by performing sequentially the discrete steps of (1) selecting a profile; (2) analyzing a reference corpus of documents against that profile to determine a score; (3) scoring a document from the data stream against the profile; and (4) comparing the score from the data

---

<sup>11</sup> Schultz, col. 1, ll. 51-57 (emphasis added).

stream document to the score from the reference corpus to select the document from said data stream. Eichstaedt, on the other hand, discloses a system where (1) a user accesses a corpus of documents; (2) a profile including a score is automatically generated from the user's document access patterns; (3) the profile is used by a webcasting system to "push" content to the user; and (4) the profile is updated.

As a primary matter, the present invention claims a sequence of distinctly different steps from those disclosed in Eichstaedt. Second, the method claimed in Eichstaedt is a method for generating and updating user profiles, not for selecting a document from a data stream, as recited in claims 2 and 3 of the present invention. Third, claims 2 and 3 of the present invention each recite separate steps for analyzing a reference corpus against a profile and for scoring a document from a data stream against the same profile. Since in Eichstaedt the user accesses a corpus of documents before the profile is generated, Eichstaedt cannot anticipate that specific claimed step.

Finally, Eichstaedt discloses "profiles [that] are constantly changing to more accurately reflect the current interests of an individual."<sup>13</sup> Therefore, it would be impossible for the same profile in Eichstaedt to be used in two sequential analyses, as recited in claims 2 and 3.

For the above reasons, the Examiner has failed to establish a *prima facie* case of anticipation. Accordingly, Applicant requests reversal of the rejection of claims 2 and 3.

**C. Rejections under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Eichstaedt in view of Cook. The Examiner has further rejected claims 6 and 7 under 35

---

<sup>12</sup> *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

<sup>13</sup> Eichstaedt, col. 1, ll. 52-55.

U.S.C. § 103(a) as being unpatentable over Eichstaedt in view of Heckerman. The Examiner has also rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Evans.

When rejecting a claim for reasons of obviousness, the Examiner bears the initial burden of establishing a *prima facie* case of unpatentability. Specifically, to establish a *prima facie* case of obviousness, there must be some evidence of a suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art to modify the reference.<sup>14</sup> Where the references cited by the examiner fail to show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references," the Examiner has not carried the burden of establishing a *prima facie* case of unpatentability.<sup>15</sup> Where the Examiner fails to establish a *prima facie* case, the rejection is improper and shall be reversed.<sup>16</sup>

The present invention as recited in claims 4 and 5 employs a series of steps involving the analysis of various data against a profile to produce scores, further analyzing the scores to determine delivery ratios that relate the various data to each other. Specifically, claims 4, 5, 6 and 7 of the present invention specify how the delivery ratios are analyzed.

#### **1. The Cited References Do Not Disclose All of the Claimed Elements**

Claims 4, 5, 6 and 7 of the present invention, which stand rejected over Eichstaedt in combination with either Cook or Heckerman, all depend from claims 2 and 3. As discussed above, Eichstaedt fails to teach or disclose, alone or in combination with other references, the

---

<sup>14</sup> MPEP 706.02(j). See also *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (explaining that the teachings or suggestion to make the claimed invention must be found in the prior art and not based upon the Applicant's disclosure.)

<sup>15</sup> *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598-99 (Fed. Cir. 1988).

<sup>16</sup> *Id.*

elements of claims 2 and 3 of the present invention. Nor has the Examiner argued that either Cook or Heckerman teaches or discloses any of the elements of claims 2 and 3. As such, no combination of Eichstaedt and Cook or Eichstaedt and Heckerman may properly be held to render claims 4, 5, 6 and 7 of the present invention obvious. Moreover, the cited references do not suggest modifying their respective disclosures to produce the claimed invention.

According to the Examiner, claim 8 of the present invention "is drawn to many of the limitations of claim 1."<sup>17</sup> As explained above, Schultz does not suggest or disclose several core elements of claims 1. The Examiner has cited the secondary reference of Evans only to render additional claim elements obvious. Since the Examiner does not contend that Evans applies to the core elements of independent claim 1, the combination of Schultz with Evans fails to render either claim 1 or claim 8 obvious.

**2. There is no Motivation to Combine Eichstaedt with Cook, Eichstaedt with Heckerman, or Schultz with Evans**

In this case, the Examiner attempts to combine Eichstaedt and Cook, Eichstaedt and Heckerman, or Schultz and Evans to render various dependent claim elements obvious. It is well settled that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination."<sup>18</sup> Although the suggestion to achieve the claimed invention may be found either explicitly or implicitly within the references themselves, there must be some evidence that the skilled artisan would select certain elements from the prior art references and combine them in

---

<sup>17</sup> Office Action, p. 6.

<sup>18</sup> *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

the manner claimed.<sup>19</sup> That is, generalizations about the specific teachings of references are insufficient to support a determination of obviousness. "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the reference."<sup>20</sup> Moreover,

a rejection cannot be predicated on the mere identification in [the references] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.<sup>21</sup>

In other words, the prior art *itself* must suggest the desirability of the modification.<sup>22</sup> Here, the Examiner has pointed to no particular teaching, suggestion or motivation in Eichstaedt and Cook, Eichstaedt and Heckerman, or Schultz and Evans to combine resources, data streams, topics and profiles with a data analysis system as claimed. Accordingly, Examiner's rejection of claims 4, 5, 6, 7 and 8 as obvious over any combination of the cited references is improper.

### **3. Use of Hindsight Reconstruction is Inappropriate to Render Claim Obvious**

Here, in order to substantiate an obviousness rejection, the Examiner must point to some particular teaching or suggestion in Eichstaedt and Cook, Eichstaedt and Heckerman, or Schultz and Evans that supports combining and modifying the references to include the claimed steps of the present invention. Moreover, when determining the issue of obviousness, the Examiner must

---

<sup>19</sup> *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1372, 56 U.S.P.Q.2d 1065, 1073 (Fed. Cir. 2000) (holding that without specific evidence to modify the teachings of prior art references, the obviousness determination, based upon such modified references, is improper).

<sup>20</sup> *In re Rouffet*, 149 F.3d 1350, 1354, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998).

<sup>21</sup> *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (holding that the Board did not make out a proper prima facie case of obviousness when it combined and modified multiple references to make the claimed invention).

<sup>22</sup> *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q.2d 1125, 1127 (Fed. Cir. 1984).



consider the claimed invention *as a whole*.<sup>23</sup> In other words, the Examiner cannot use hindsight reconstruction to render the present invention obvious. The fact that the Examiner had to pick and choose discrete portions from each of the cited references to render the dependent claims of the present invention obvious shows that the invention would not have been obvious to a person of ordinary skill in the art at the time the invention was made. That is, the Examiner used the Applicant's disclosure as a blueprint to render the present invention obvious. Such hindsight reconstruction is certainly improper.<sup>24</sup> Accordingly, all pending claims are patentable.

#### **D. Other Pending Claims**

All other pending claims—claims 9-20—according to the Examiner "do not teach or define above the correspondingly rejected claims 1-8 and thus claims 9-20 are rejected for the reasons given above."<sup>25</sup> Claims 1-8 have been shown above to be patentable. Thus, the other pending claims are also patentable.

---

<sup>23</sup> *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 U.S.P.Q.2d 1021, 1024 (Fed. Cir. 1984).

<sup>24</sup> *In re Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1457.

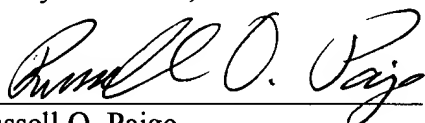
<sup>25</sup> Office Action, p. 6.



Conclusion

Because (i) Schultz, Eichstaedt, Eichstaedt and Cook, Eichstaedt and Heckerman, or Schultz and Evans, either individually or in combination, fail to disclose all of the elements of claims 1-20 as currently presented, and (ii) because the Examiner has not pointed to any portion of Eichstaedt and Cook, Eichstaedt and Heckerman, or Schultz and Evans that suggests modifying any of those references to produce the claimed invention, the pending claims are patentable in view of the three cited references. Accordingly, Applicant respectfully requests reversal of the rejection of claims 1-20 over the cited references. Applicant further respectfully requests withdrawal of the rejection of claims 5, 7, 12, 14, 18 and 20 under 35 U.S.C. § 101.

Respectfully submitted,

By:   
Russell O. Paige  
Reg. No. 40,758

Jones Day  
51 Louisiana Avenue, N.W.  
Washington, DC 20001-2113  
Tel. (202) 879-3939

Date: February 9, 2004